

Appl. Ser. No. 09/504,070

Att. Docket No. 10746/16

Reply to Final Office Action of February 24, 2004

REMARKS

Claims 72 to 116 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

Applicants thank the Examiner for considering the Information Disclosure Statements, PTO-1449 forms and related references.

With respect to paragraph one (1) of the Final Office Action, the objections was not ignored in the prior response. It was traversed since it was believed and respectfully submitted that the present specification fully complies with Rules 52(a) and 52(b), and it was stated that the Application has been reviewed, and it was not understood how the specification is not a proper English translation. It was also stated that if the Office insisted on a Substitute Specification, it was respectfully requested that the Office specifically identify how the present application does not satisfy the statutory and rule requirements, since no examples were provided in the Office Action. It was also noted that the assignee of the present application has previously submitted many cases that were considered proper. It is not understood how the present application does not satisfy any specific statutory or regulation requirements, and it is therefore not understood what would be changed. It was therefore respectfully requested that the Substitute Specification requirement be withdrawn.

In view of the current comments, while the objection to the use of the terms “means” and “said” in the specification may not be agreed with, a Substitute Specification accompanies this response, in which “said” has been changed to “the”, and in which “means” has been changed to apparatus or arrangement.

In particular, in accordance with 37 C.F.R. § 1.125, the Substitute Specification contains no new matter. The amendments reflected in the Substitute Specification are to conform the Specification to U.S. Patent and Trademark Office rules or to correct informalities. As required by 37 C.F.R. § 1.121 and § 1.125, a Marked Up Version Of The Substitute Specification comparing the Specification of record and the Substitute Specification also accompanies this response. In the Marked Up Version, underlining indicates added text and “strike-throughs” and double-brackets indicate deleted text. Approval and entry of the Substitute Specification is respectfully requested.

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It is therefore respectfully requested that the objections be withdrawn as to the specification in view of the submission of the Substitute Specification.

With respect to paragraph three (3), claim 79 were rejected under the second paragraph of 35 U.S.C. § 112 as indefinite, because it included multiple spaces between the words “from” and “the” in the “second storing means” clause of claim 79. While the rejection may not be agreed with, to facilitate matters, claim 79 has been corrected as suggested.

With respect to paragraph five (5), claims 72 to 116 were rejected under 35 U.S.C. § 102(b) as anticipated by Samson, U.S. Patent No. 5,287,408.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), *the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)).* Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)*).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See M.P.E.P. § 2112; emphasis in original; and see Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)*). *Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.* Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

In view of the law of anticipation and in view of the claimed subject matter, the anticipation rejections are traversed for the following reasons.

To “support” its anticipation rejections, the Final Office Action conclusorily and wrongly asserts that the “manifest” language of the claims corresponds to the “program” of

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the “Samson” reference, and also essentially and wrongly asserts that the “signature” of the claims is the same as the public/private key of the “Samson” reference.

In the present specification, the term “signature” or “digital signature” is a “correct signature that is signed (for example, by S_{pk}) for information (for example, information “x”), and the manifest represents a function of the information and the signature. (See, e.g., Specification, page 16, lines 15 to 17; page 17, lines 21 to 24). Still further, for example, at lines 10 to 20 of page 31 of the Specification states, for example, that the “manifests of the number which the signer intends to store are stored” -- and the signer referred to is of course the signer of the signature. This is only a sample of the references to the terms “manifest” and “digital signature” or “signature” which may be found throughout the Specification. Nowhere is it suggested that a manifest may be a program, and that a signature may just be a public or private key.

In short, the Final Office Action apparently reflects its own unrestricted and therefore unreasonable reading of the above-discussed terms without regard to the sense in which those phrases and terms are used in the specification.

The law plainly supports the foregoing eminently reasonable interpretation of “manifest”, “digital signature”, and “signature” based on the specification. (See *In re Weiss*, 26 U.S.P.Q.2d 1885, 1887 (Fed. Cir. 1993) (when interpreting a claim term or phrase, one must “look to the specification for the meaning ascribed to that term”; Board reversed) (unpublished decision); *In re Okuzawa*, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976) (“claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest *reasonable* interpretation”; Board reversed; emphasis in original) (citing *In re Royka*, 180 U.S.P.Q. 580, 582-83 (C.C.P.A. 1974) (claims are “not to be read in a vacuum and while it is true that they are to be given the broadest reasonable interpretation during prosecution, their terms still have to be given the meaning called for by the specification of which they form a part”; Board reversed; emphasis in original); and *In re Rohrbacher*, 128 U.S.P.Q. 117, 119 (C.C.P.A. 1960) (an “applicant is his own lexicographer and words used in his claims are to be interpreted in the sense in which they are used in the specification”; Board reversed)).

That is exactly the case here since contrary to the foregoing law, the Final Office Action simply reflects its own unreasonable reading of “manifest”, “digital signature”, and

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“signature” without regard to the sense in which those terms are used in the specification.

This is evidenced by the Office Action reading “manifest” to cover the program of “samson”, and “signature” or “digital signature” to cover a public or private key.

In this regard, “Samson” only refers to an apparatus and method of disabling an unauthorized copy of a computer program, in which a dedicated computer program *is used to generate a particular set of license numbers*, in which *a separate program embeds the license numbers into valid copies of the computer program*, and *the computer program also includes a section for verifying its license number*. When a program is attempted to be run, the validation procedure verifies the license number. If the license number does not have the uncommon mathematical property, an error message is generated and the program exits. Accordingly, any review of the “Samson” reference makes plain that it simply does not in any way identically describe (or even suggest) the claimed subject matter, including the features of “manifest” and “signature”, as provided for in the context of the rejected claims, as any Appeals Board would completely and readily agree.

In particular, for example, claim 72 is directed to a data storing method of storing digital information which has a value, the data storing method is used in a system including an issuer apparatus issuing the digital information and a user apparatus, the method comprising: *adding, by the issuer apparatus, a signature to the digital information; generating, by the issuer apparatus, a manifest corresponding to the digital information; generating, by the issuer apparatus, accreditation information with the signature*, and *sending the digital information with the signature and the accreditation information with the signature to the user apparatus*, wherein the accreditation information indicates third parties that are trusted by the issuer apparatus and that trust the user apparatus; receiving, by the issuer apparatus, session information from the user apparatus, and sending information that includes the *manifest* and the session information, to the user apparatus; and verifying, by the user apparatus, the *manifest* and the session information, and *storing the manifest in the user apparatus only when the manifest and the session information are verified*.

None of these features are in any way identically described by the “Samson” reference for the reasons explained above.

Accordingly, claim 72 is allowable for the above reasons.

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Independent claims 73, 77 to 80, 84 and 85 include the “manifest” and “signature” features like that of claim 72 and are therefore allowable for essentially the same reasons as claim 72.

Claims 74 to 76 depend from claim 73, and are therefore allowable for the same reasons as claim 73.

Claims 81 to 83 depend from claim 80, and are therefore allowable for the same reasons as claim 80.

Independent claim 86 is directed to an original data circulation method in an original data circulation system for storing or circulating original data which is digital information, the method comprising: sending, *by a first apparatus, originality information to a second apparatus, the originality information including a fingerprint corresponding to a source apparatus of the original data and second information corresponding to the original data, and performing an authentication step of identifying and authenticating, by the second apparatus, the source apparatus, verifying whether the source apparatus is the same as an apparatus corresponding to the fingerprint, and determining that the originality information is valid if the source apparatus is the same as an apparatus corresponding to the fingerprint.* It is respectfully submitted that the features corresponding to the *fingerprint corresponding to a source apparatus of the original data* are not in any way identically described (or even suggested) by the “Samson” reference. Indeed, none of the analysis in the Final Office Action even conclusorily asserts that the “Samson” reference identically describes these features. The Final Office Action apparently relied on the “analysis” of claim 72 to reject the claim of 86, which recites different claim features than does claim 72.

Accordingly, claim 86 is allowable for the above reasons.

Claims 87 to 90 depend from claim 86 and are therefore allowable for the same reasons as claim 86.

Claim 91 includes the “fingerprint” features like those of claim 86, and is therefore allowable for essentially the same reasons as claim 86.

Claims 92 to 95 depend from claim 91 and are therefore allowable for the same reasons as claim 91.

While the rejection of claim 96 may not be agreed with, to facilitate matters, its language is now more like that of claim 86, as to the “fingerprint” features. Independent

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claim 96 as now presented is directed to an issuer apparatus in an original data circulation system for storing or circulating original data which is digital information, the issuer apparatus comprising: *originality information generation means for generating originality information which includes a fingerprint corresponding to the issuer apparatus of the original data and second information corresponding to the original data; and originality information sending means for sending the originality information.* It is respectfully submitted that these “fingerprint” features are not identically described (or even suggested) by the “Samson” reference. In fact, the Final Office Action does not even conclusorily assert or explain how this is so (which it is not), so that claim 96 is allowable.

Claims 97 to 98 depend from claim 96 and are therefore allowable for the same reasons as claim 96.

Claim 100 includes “fingerprint” features like those of claim 86, and is therefore allowable for essentially the same reasons as claim 86.

Claim 101 depends from claim 100 and is therefore allowable for the same reasons as claim 100.

While the rejection of claim 102 may not be agreed with, claim 102 as presented is directed to a collector apparatus in an original data circulation system for storing or circulating original data which is digital information, the collector apparatus comprising: *identifying means for identifying a source apparatus of originality information; authentication means for authenticating the source apparatus; and data processing means for performing a process corresponding to the original data if the authentication means determines that the originality information which is sent to the collector apparatus is valid, in which the originality information includes a fingerprint corresponding to the source apparatus of the original data.* It is respectfully submitted that the “fingerprint” features are not identically described (or even suggested) by the “Samson” reference, as explained above, so that claim 102 is allowable.

Claim 103 depends from claim 102 and is therefore allowable for the same reasons as claim 102.

While the rejection of claim 104 may not be agreed with, to facilitate matters, its language is now more like that of claim 86, as to the “fingerprint” features. In particular, claim 104 as presented is directed to an original data circulation system for storing or

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circulating original data which is digital information, the original data circulation system comprising: *an issuer apparatus which includes means for generating originality information and sending the originality information, the originality information including a fingerprint corresponding to the issuer apparatus of the original data and second information corresponding to the original data; a user apparatus which includes means for verifying validity of a source apparatus of the originality information and means for storing the originality information when the validity is verified; and a collector apparatus which includes means for verifying validity of a source apparatus of the originality information and data processing means for performing a process on the original data if the validity is verified.* It is respectfully submitted that these features involving the “fingerprint” feature of the issuer apparatus are not identically described (or even suggested) by the “Samson” reference, so that claim 104 is allowable.

While the rejection of claim 105 may not be agreed with, to facilitate matters, its language is now more like that of claims 96 and 100, as to the “fingerprint” features, so that claim 105 is allowable for essentially the same reasons as these claims.

Claims 106, 107 and 108 depend from claim 105 and are therefore allowable for the same reasons as claim 105.

While the rejection may not be agreed with, to facilitate matters, claim 109 as presented includes “fingerprint” features analogous to those of claim 96, and is therefore allowable for essentially the same reasons as claim 96.

Claims 110, 111 and 112 depend from claim 109 and are therefore allowable for the same reasons as claim 109.

Independent claim 113 is directed to a computer readable medium storing program code for causing a computer in an original data circulation system to store or circulate original data which is digital information, the computer being used as a user apparatus, the computer readable medium comprising: *originality information sending program code means for sending originality information which includes a fingerprint corresponding to a source apparatus of the original data and second information corresponding to the original data; identifying program code means for identifying the source apparatus of the originality information; authentication program code means for determining that the originality information is valid if the source apparatus is authenticated and an apparatus*

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corresponding to the fingerprint and the source apparatus are the same; and storing program code means for storing the originality information if the authentication program code means determines that the originality information is valid. As with claim 100, it is respectfully submitted that these “fingerprint” features are not identically described (or even suggested) by the “Samson” reference, so that claim 113 is allowable.

Claim 114 depends from claim 113 and is therefore allowable for the same reasons as claim 113.

While the rejection of claim 115 may not be agreed with, to facilitate matters, its language is now more like that of claim 86, as to the “fingerprint” features. Independent claim 115 is directed to a computer readable medium storing program code for causing a computer in an original data circulation system to store or circulate original data which is digital information, the computer being used as a collector apparatus, the computer-readable medium comprising: *identifying program code means for identifying a source apparatus of originality information; authentication program code means for authenticating the source apparatus; and data processing program code means for performing a process corresponding to the original data if the authentication program code means determines that the originality information which is sent to the collector apparatus is valid, in which the originality information includes a fingerprint corresponding to the source apparatus of the original data.* As explained above, it is respectfully submitted that these features are not identically described (or even suggested) by the “Samson” reference, so that claim 115 as presented is allowable.

Claim 116 depends from claim 115 and is therefore allowable for the same reasons as claim 115.

In summary, it is respectfully submitted that all of claims 72 to 116 of the present application are allowable at least for the foregoing reasons.

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CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 72 to 116 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

KENYON & KENYON

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By: 

Aaron C. Deditch
(Reg. No. 33,865)

One Broadway
New York, New York 10004
(212) 425-7200

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